

REMARKS

Claims 1-39 (claims renumbered) are pending in the Application. The Examiner has noted that claims 23-38 were misnumbered and that they should be renumbered to claims 24-39. The Examiner has rejected claims 1-39 under 35 U.S.C. §103(a). Applicants respectfully traverse these rejections for at least the reasons stated below and respectfully request that the Examiner reconsider and withdraw these rejections.

I. CLAIM OBJECTIONS:

The Examiner has noted that claims 23-38 were misnumbered and that they should be renumbered to claims 24-39. Paper No. 3, page 2. Applicants renumbered claims 23-38 to be claims 24-39 as indicated above.

The Examiner has further noted that there are typographical errors in claims 31-34 and 36-39 in that these claims depend from incorrect claims due to the error in numbering. Paper No. 3, pages 2-3. Applicants amended claims 31-34 and 36-39 to depend from the correct claims as indicated above. Applicants note that claims 31-34 and 36-39 were not amended to overcome prior art but to correct typographical errors due to the error in numbering. Hence, no prosecution history estoppel arises from the amendments to claims 31-34 and 36-39. *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-1712 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 31-34 and 36-39 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. *See Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Accordingly, Applicants respectfully request the Examiner to withdraw the objections to the claims.

II. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 1, 12, 30 and 31 under 35 U.S.C. §103(a) as being unpatentable over Corl, Jr. et al. (U.S. Patent No. 6,529,897) (hereinafter "Corl") in view of Murase (U.S. Patent Publication No. 2001/0028651) (hereinafter "Murase"). The Examiner has further rejected claims 2, 3, 15, 16, 17, 27 and 32-39 under 35 U.S.C. §103(a) as being unpatentable over Corl in view of Murase and in further view of Hunter et al. (U.S. Patent No. 6,343,289) (hereinafter "Hunter"). The Examiner has further rejected claims 4-11, 13, 14, 18-26, 28 and 29 under 35 U.S.C. §103(a) as being unpatentable over Corl in view of Murase and in further view of Hunter and in further view of Basso et al. (U.S. Patent Application No. 2002/0154634) (hereinafter "Basso").

The reference Corl, which only qualifies as prior art under 35 U.S.C. § 102(e), does not preclude patentability under 35 U.S.C. §103 since Corl and the claimed invention in claims 1-39 were at the time the invention was made, subject to an obligation of assignment to the same person, which in this case was International Business Machines Corporation. Thus, Corl is disqualified as being used as a prior art reference under 35 U.S.C. §103(c). Consequently, the rejections of claims 1-39 are moot.

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicants that claims 1-39 in the Application are in condition for allowance, and Applicants respectfully request an allowance of such claims. Applicants respectfully request that the Examiner call Applicants' attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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